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In re Application of WOOLFE et al.
Application No.: 10/516,943
PCT No.: PCT/GB03/02669
Int. Filing: 20 June 2003
Priority Date: 22 June 2002
Attorney Docket No.: 00303/US
For: PHARMACEUTICAL COMPOSITION

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: DECISION ON PETITION
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: UNDER 37 CFR 1.47(a)
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This is a decision on applicant's petition under 37 CFR 1.47(a), filed in the United States Patent and Trademark Office (USPTO) on 17 November 2005, to accept the application without the signatures of joint inventors, Jacqueline Yvonne Allen and Mark Clifford Elliot.

BACKGROUND

On 16 December 2004, applicant filed a transmittal letter (PTO-1390) requesting entry into the national stage in the United States of America under 35 U.S.C. § 371. Filed with the Transmittal Letter was, *inter alia*, the requisite basic national fee.

On 17 May 2005, a Notification of Missing Requirements (FORM PCT/DO/EO/905) was mailed to applicant indicating *inter alia*, that an oath or declaration in accordance with 37 CFR 1.497(a) and (b) and the surcharge for filing the oath or declaration after the thirty month period was required.

On 17 November 2005, applicant filed the instant petition along with a declaration, executed by the joint inventors on behalf of the nonsigning inventors. The petition under 37 CFR 1.47(a) in an attempt to satisfy the requirements of 35 U.S.C. 371(c)(4) requested the acceptance of the application without the signatures of inventors Jacqueline Yvonne Allen and Mark Clifford Elliot, alleging that Ms. Allen refuses to sign the application and Mr. Elliot is unavailable.

DISCUSSION

A petition under 37 CFR §1.47(a) must be accompanied by (1) the fee under 37 CFR §1.17(g), (2) factual proof that the non-signing joint inventor(s) refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the non-signing inventor(s), and (4) an oath or declaration by each available joint inventor on his or her own behalf and on behalf of the non-signing joint inventor(s).

The petition included the requisite petition fee, satisfying Item (1). Item (3) is satisfied because the last known addresses of non-signing inventors were provided. With regard to item

(4), the declarations executed by the available joint inventors on their behalf and on behalf of the non-signing inventors were submitted and satisfies this requirement of 37 CFR 1.47(a).

Inventor Allen's Refusal to Sign

With respect to Item (2) above, Petitioner indicated that a declaration by a member of the patent department of Norton Healthcare Ltd. was attached, detailing the efforts made to obtain the nonsigning inventor's signatures. However, the only declaration submitted was that of counsel Michael Steinberg, which was not a statement of first hand knowledge and did not provide details of the attempts made or diligent efforts to contact the nonsigning inventors.

Mr. Steinberg states that a copy of the patent application along with declaration was sent to Ms. Allen by Simone Frankel. However, a statement from Ms. Frankel detailing her efforts to contact Ms. Allen was not provided. Nor was a copy of the letter to Ms. Allen requesting her signature on the application provided. Moreover, Mr. Steinberg states that Ms. Allen acknowledged by phone that she received these documents but that she refused to sign the declaration. Mr. Steinberg does not state that he spoke to Ms. Allen. If he did, the date and time of her refusal and reason for her refusal, if she so stated, should be provided.

Petitioner has not provided evidence that a complete copy of the application papers, including specification, claims and drawings and declaration, were provided to Ms. Allen. What is required is that Ms. Allen be presented with a copy of all of the national stage application papers (specification, including claims and drawings, oath or declaration) for this application. Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. See Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP), Proof of Unavailability or Refusal.¹

¹ A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.... It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted. Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in a statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

Unavailability of Inventor Elliot

With respect to counsel's inability to find or reach Mr. Elliot, Petitioner states that "diligent efforts have been made by members of the Patent Department of Norton Healthcare Ltd. to locate Ms. Allen and Mr. Elliot and obtain their signatures on the declaration, but these efforts have been unsuccessful." Mr. Steinberg further states that the copy of the application and declaration were sent to Mr. Elliot by Ms. Frankel and were returned by the postal service as undeliverable. However, a statement by Ms. Frankel, the person with first hand knowledge, which fully describes the exact facts relied on to establish that a diligent effort was made, was not submitted.

As indicated in the MPEP Section 409.03(d), where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included in the statement of facts. It is important that the statement contain facts as opposed to conclusions.

Here, diligent efforts made to locate Mr. Elliot were not pursued and documented, such as Internet searches, E-mail contact to obtain a current address, contact with his former employer or joint inventor to obtain a forwarding address or a request from the Postal Service for his forwarding address. Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a "diligent effort" was made. Petitioner's statement of facts under 37 CFR 1.47(a) does not indicate that any search for Mr. Elliot's new address was made. Since no attempts to locate inventor Elliot were documented, it can not be concluded that "a diligent effort" was made to locate the non-signing inventor.

The action taken by petitioner is not sufficient to prove that "a diligent effort" was made to contact the nonsigning inventor. Under these circumstances, it cannot be concluded that Mr. Elliot is unavailable to sign the application.

In sum, Petitioner has satisfied Items (1), (3) and (4) above. However, Petitioner has not satisfied Item (2) by demonstrating: (1) a *bona fide* attempt was made to present a copy of the application papers for U.S. application 10/516,943 (specification, including claims, drawings, and declaration) to the nonsigning inventors for their signature and Ms. Allen's refusal to sign, either in writing or by telephone, these documents and (2) that "a diligent effort" was made to contact the nonsigning inventor Mark Clifford Elliot. Accordingly, it is inappropriate to accord the national stage application status under 37 CFR §1.47(a) at this time.

CONCLUSION

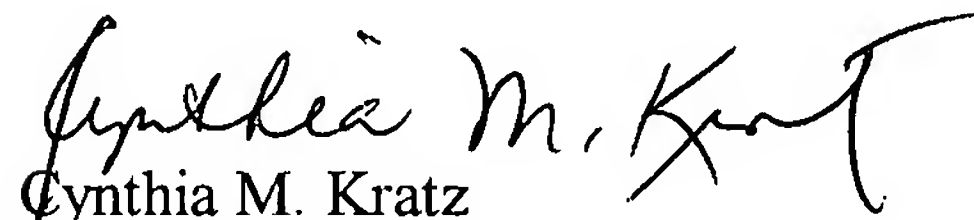
The petition under 37 CFR §1.47(a) is **DISMISSED WITHOUT PREJUDICE**.

Any reconsideration on the merits of the petition under 37 CFR §1.47(a) must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR §1.47(a)." No petition fee is required. Any further extensions of time available may be obtained under 37 CFR 1.136(a).

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Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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